

REMARKS

In the Office Action, claims 13-20 were rejected on the ground of obviousness-type double patenting as being unpatentable over claims 10-27 of copending U.S. Patent Application No. 10/505,469. In addition, claims 13-15 and 17-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Navas (U.S. Patent No. 5,375,823) in view of Clayton Jr. (U.S. Patent No. 4,445,674).

For the reasons set forth below, Applicant asserts that the rejections are improper and should be withdrawn.

Restriction Requirement

The Examiner required restriction between claims 13-20 and claims 21-27. The Office Action states that claims 13-20 were constructively elected for prosecution on the merits, based on election by original presentation, and the Examiner withdrew claims 21-27 from consideration. Applicant does not agree that claims 21-27 are independent or distinct, as alleged by the Examiner. In particular, Applicant asserts that claims 21-27 provide a "process for joining vertebral implants" that requires the structure recited in independent claim 13. For this reason, restriction between the groups of claims is improper.

As explained below, claims 13-20 are allowable in view of the cited art. Should the Examiner make the restriction requirement final, Applicant submits that rejoinder of claims 21-27, upon allowance of claims 13-20, would be proper because claims 21-27 require the structure recited in independent claim 13.

**The Obviousness Type Double Patenting Rejection Is Improper Because
the Claims of Application 10/505,469 Are Patentably Distinct**

The Office Action indicates that “the difference between claims 13-20 of the current application and claims 20-27 of the copending application lies in the fact that the current application claims include many more elements and is thus much more specific. Thus the invention of claims 13-20 are in effect a “species “ of the “generic” invention of claims 20-27.” (Office Action at page 3).

Applicant disagrees with the Patent Office’s interpretation of these claims. The independent claims (13 in the present application and 20 in the copending application) each include claim elements that are not recited in the other. First, as acknowledged by the Examiner, claim 13 includes elements not recited in claim 20. (Office Action at page 3). In addition, claim 20 of the copending application includes limitations not recited in claim 13 of the current application. Specifically, claim 20 of the copending application recites “the opening in the cylindrical body portion second end having a width that is less than a width of the enlarged end portion but is greater than a width of the first elongated body to allow the second rod portion to laterally bend with respect to the cylindrical body portion.” At least this element is not present in claim 13 of the present application, or in any dependent claim, and, therefore, it is incorrect to state that the difference between claim 20 and claim 13 is that claim 13 includes many more elements, or that the present claims are a species of the copending genus.

Therefore, because the claims of the present application and the copending application each contain patentably distinct elements not recited in the other, the provisional double patenting rejection is improper and should be withdrawn.

The Rejections Under Section 103(a) Should Be Withdrawn

Applicant submits that the proposed combination of Navas and Clayton fails to support a *prima facie* case of obviousness because there is no motivation to use the teachings of Clayton to modify Navas. Clayton discloses a shock absorber for an oil well, which is a field that is clearly different than the field of spinal implants--the focus of this application. Applicant recognizes that "a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself of an inventor's attention in considering his or her invention as a whole." M.P.E.P. §2141.01(a). However, the inclined face of the shock absorber of Clayton is directed to problems that have absolutely no relevance to spinal implants, and therefore, the rejection under section 103(a) based on Clayton is improper.

"To rely on a reference under 35 U.S.C. 103, it must be analogous art." Id. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007). However, there must be at least some reasonable basis, or need or problem, that provides an articulable reason why a reference would have commended itself of the attention of one skilled in the art. Here there is none.

(a) Heat Dissipation is Not a Problem Addressed by Navas or in the Spinal Implant Field

The Examiner states that, “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Navas wherein each of the dampening elements include at least one inclined face in view of Clayton Jr. in order to help transfer heat from the device caused by friction.” However, neither Applicant’s devices nor Navas’s disclosure address this problem. Rather, Applicant’s devices and Navas’s disclosure are directed to spinal implants, an area in which heat dissipation is not a known problem. Further, there is absolutely nothing in Navas’s disclosure to indicate that friction occurs and creates heat. Therefore, the need to “help transfer heat from the device caused by friction” is not a need or problem known in the spinal implant field nor is there any suggestion that Navas’s device has such a need or would benefit from such a modification.

Consequently, there is no motivation to combine the teachings of Clayton with Navas. The need for heat transfer is not a problem encountered in the spinal implant field, and Navas does not address this issue in any way. Rather, the relatively slow and limited movement of portions of spinal devices relative to one another or the body, coupled with the fact that individuals in whom these implants are placed will often rest or remain stationary make heat dissipation irrelevant. This is in sharp contrast to the oil wells that will move continuously for hours or days, perhaps in the desert heat, which are the subject of the Clayton patent.

(b) Motivation to Use Clayton Does Not Exist

Further, the inclined faces of Clayton serve no purpose other than heat dissipation and are not directed to any problem that would commend Clayton to the attention of one skilled in the art of spinal implants. Clayton is not directed to any problem that might be considered common or relevant to any portion of the field of spinal implants, and thus, one would not be motivated to provide an inclined face on each of the dampening elements of Navas for such a purpose.

Therefore, there is no “articulable reason why [Clayton] would have commended itself of the attention of one skilled in the art.” *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007). Consequently, the rejection under section 103 based on Navas in view of Clayton is improper and should be withdrawn.

(c) The Additional Rejections of Claims 19 and 20 Are Improper

In addition, the rejections of claim 19 based on the holding in In re Japikse, and claim 20 as a matter of design choice, are also improper. First, regarding claim 19, the M.P.E.P. summarizes Japikse, stating that in Japikse, “claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.” M.P.E.P. § 2144.04. However, in the present case, the claimed opening “is an opening in the cylindrical body portion second end”, and, therefore, is not merely a rearrangement of parts, but defines the structure of the cylindrical body. Further, unlike Japikse, where only the position of a switch was moved without changing the operation of the device, the location of the opening in the cylindrical body provides a structural and functional difference. Specifically, the

eccentrically located opening allows one rod member to extend through the opening at an angle, as shown in Fig. 13, whereas a centrally located opening, if narrow, would confine the rod to an axial orientation. For these reasons, the rejection of claim 19 is improper and should be withdrawn.

With regard to claim 20, which provides that the "opening in the cylindrical body portion second end includes an oblong shape," the Office Action states that "applicant has not disclosed that such solved any stated problem or is anything more than one of numerous shapes or configurations a person ordinar[ill]y skill[ed] in the art would find obvious." (Office Action at page 6). Applicant respectfully disagrees. Applicant has indicated the particular purpose of the oblong shape, which cannot be accomplished by selection of any one of numerous shapes or configurations as alleged by the Examiner. Specifically, as stated at paragraph 45 of the instant application, "the rod 110 can function in tension/compression and in flexion following a preferred axis which can be for instance in the sagittal plane of the spinal column...this also is the case where the means 119 is oblong or eccentric. (FIG. 16)." Therefore, the oblong opening is selected to control movement along a defined path, and has a specific purpose not contemplated in the prior art. For these reasons, the rejection of claim 20 is improper and should be withdrawn.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 17, 2008

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